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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Markus Allemann

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11/02/2007

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

GATES, ERIC ANDREW

ART UNIT

PAPER NUMBER

3722

MAIL DATE

DELIVERY MODE

11/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/757,660

Applicant(s)

ALLEMANN ET AL.

Examiner

Eric A. Gates

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on 23 August 2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Crutchfield (U.S. Patent 4,866,319).
4. Regarding claim 1, Crutchfield discloses a control mechanism 28/66/76 for a rotary hand tool 10 having a generally cylindrical housing 12 in which a drive motor 26 is located, the housing having a generally tapered nose portion 14 at an end from which a motor output shaft 24 extends (see figure 2, shaft 24 extends (primary definition "to stretch out", per Oxford online dictionary) from motor 26 in the nose portion) and a grip portion 14 around which an operator can wrap a hand during operation of the tool and within which portion the motor is housed, said control mechanism 28/66/74 being a part of the tool and located substantially within the housing thereof and comprising: an electrical control circuit 74 contained entirely within said housing, said circuit controlling the application of power to and the operation of the motor, including supplying current to

Art Unit: 3722

the motor; and a light touch switch 30 having at least a first position (not pushed) and a second position (pushed) (see column 4, lines 46-68) coupled to said electrical control circuit (mechanically coupled through contact with microswitch 78) for selectively enabling or disabling said control circuit to turn the motor on and off, wherein said motor current does not flow through said switch 30; wherein said switch 30 is disposed on the tapered nose portion 14 of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool.

5. Regarding claim 2, Crutchfield discloses wherein said switch 30 is configured to be generally rectangular (exterior portion 88 as viewed from above in figure 1).

6. Regarding claim 3, Crutchfield discloses wherein said switch 30 has a predetermined thickness (it is inherent that the switch would be made with a predetermined thickness)

7. Regarding claim 4, Crutchfield discloses wherein said first position disables said electrical control circuit and said second position enables said electrical control circuit (see column 3, lines 41-48).

8. Regarding claim 5, Crutchfield discloses wherein the tapered nose portion on which said switch 30 is disposed generally corresponds to a location of the operator's index finger when grasping the tool (see figure 1).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3722

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crutchfield in view of Von Hollen (U.S. Patent 3,640,635).

11. Regarding claim 6, Crutchfield discloses the invention substantially as claimed, except Crutchfield does not disclose a layer of flexible grip material surrounding at least a portion of the nose portion.

Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible material is compressed, for the purpose of providing a yielding surface in the nose portion of the tool. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Crutchfield with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

12. Regarding claims 7-9, the modified invention of Crutchfield discloses the invention substantially as claimed.

13. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crutchfield (U.S. Patent 5,712,543) in view of Peot (U.S. Patent 4,777,393).

14. Regarding claim 10, Crutchfield discloses an apparatus 28 for selectively controlling power applied to and the operation of the motor 26 of a rotary hand tool 10 having a generally cylindrical housing 12 that includes a generally tapered nose portion

Art Unit: 3722

14 that has a gradually reduced circumference toward an end from which an output shaft 24 extends (see figure 2, shaft extends (primary definition "to stretch out", per Oxford online dictionary), and a grip portion 14 around which an operator wraps a hand during operation of the tool, said apparatus comprising: electrical control circuitry 28/66/74 for controlling power, including motor current that is applied to the motor, said electrical circuitry being a part of the tool and located entirely within the housing; a switch 30 having a switch button 88 and containing at least a pair of switch contacts 80/86 that are selectively opened and closed responsive to actuation of said switch button, said switch 30 being operatively connected to said control circuitry to control the operation of the motor (switch 30 is mechanically connected to the control circuitry through contact with microswitch 78), including the application of motor current to the motor, said switch 30 being a part of the tool 10 and located substantially within the tapered nose portion 14 thereof; and a cavity (see figure 2) disposed in the nose portion of the tool that is configured to receive at least a portion of said switch 30 and permit actuation of said switch button 88.

Crutchfield does not distinctly disclose said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor. Peot teaches the use of a tool assembly that includes an on/off switch 36 and a separate speed control circuit 32 and switch 34 for the purpose of operating the tool at variable speeds. Switch 34 contains at least a pair of switch contacts (see figure 2) that are selectively opened and closed responsive to actuation of said switch button, said switch 34 being operatively connected to said control circuitry to control the

operation of the motor 20, including the application of motor current to the motor, said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor (when switch 34 is open and switch 36 is closed), and said switch is a part of the tool and as is capable of being located substantially within the tapered nose portion of the tool of Crutchfield, as it would have been obvious to place a variable speed switch wherever it would be convenient for the operator to use, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Crutchfield with the speed control circuit and switch of Peot in order to have a tool that has variable speed capabilities.

15. Regarding claim 12, Crutchfield discloses that the outer surface of said switch button 88 is generally coextensive with the outer surface of said nose portion 14 (see figure 1).

16. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crutchfield in view of Peot and further in view of Von Hollen (U.S. Patent 3,640,635).

17. Regarding claim 11, the modified invention of Crutchfield discloses the invention substantially as claimed, except Crutchfield does not disclose a layer of grip material surrounding at least a portion of the grip portion in which said switch is located.

Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible

material is compressed, for the purpose of providing a yielding surface in the grip portion of the tool. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Crutchfield with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

Response to Arguments

18. Applicant's arguments filed 23 August 2007 have been fully considered but they are not persuasive.

19. Applicant's argument that the switch button device 30 of Crutchfield is not a switch as claimed in claim 1 is not persuasive. Webster's Online Dictionary defines a switch as "a device for making, breaking, or changing the connections in an electrical circuit". This definition and the claim language do not require that the switch be a part of the electrical linkage, and as such the mechanical switch 30 of Crutchfield meets the requirements of the claim.

20. Applicant's argument that the combination of Crutchfield and Peot as used in the rejection of claim 11 does not teach the "switch being configured so that motor current does not pass through the switch contacts during operation of the motor" is not persuasive, as Applicant has not addressed the wording of the rejection, instead arguing about the general operation of the Peot reference. The rejection states that "motor current does not pass through the switch contacts during operation of the motor (when switch 34 is open and switch 36 is closed)". The switch contacts, defined as the

Art Unit: 3722

switch contacts for switch 34 in the rejection of the claim, do not pass the motor current when switch 34 is open, as described in the rejection.

21. For the reasons as set forth above, the rejections are maintained.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG
30 October 2007


MONICA CARTER
SUPERVISORY PATENT EXAMINER